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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,952	03/27/2001	Toru Teshima		5247

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LORUSSO & LOUD
3137 Mount Vernon Avenue
Alexandria, VA 22305

EXAMINER	
PHU, SANH D	
ART UNIT	PAPER NUMBER
2682	8

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,952

Applicant(s)

TESHIMA, TORU

Examiner

Sanh D Phu

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 13-25 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the Election filed on 6/10/054.

Accordingly, claims 1-12 and 26 have been selected.

Claim Rejections – 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed

before November 29, 2000. Therefore, the prior art date of the reference is

determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3-12 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Obradovich et al (6,754,485).

As per claim 1, see figures 2-4, 6 and 7, and col. 5, line 16 to col. 15, line 20, Obradovich et al discloses a method (see figure 2) comprising:

step (109) for transmitting current position information from a mobile communication instrument to an advertisement information delivery apparatus;
and

step (222, 230) for delivering advertisement information from the advertisement information deliver apparatus to the mobile communication instrument based on the current position information.

As per claim 26, see figures 1-4, 6 and 7, and col. 3, line 54 to col. 15, line 20, Obradovich et al discloses a system (see figure 1) comprising:

current position detecting means (141) for detecting current position;
a display screen (139) (see figures 1 and 7) for displaying picture images;

storage means (430, 419) (see figures 4 and 6) for storing advertisement information related to a designed location where the advertisement information is to be presented; and

advertisement presentation control means (405, 721, 725, 727) (see figure 7) for presenting advertisement information relating to designated location on said screen when the detected current position agrees with the designated location.

As per claim 3, figures 1-4, 6 and 7, and col. 3, line 54 to col. 15, line 20, Obradovich et al discloses a system (see figure 2) comprising:

advertisement information deliver apparatus (230) including advertisement information storage means for storing advertisement information to be delivered to a mobile communication instrument (109) at a location designated by a sponsor of the advertisement information;

a mobile communication instrument (109) for detecting current position and transmitting the detected current position to the advertisement delivery apparatus, for receiving said advertisement information and for outputting an

advertisement based on the received advertisement information (see figures 1 and 7, and col. 3, lines 51–62), and

wherein said advertisement information delivery apparatus retrieves, from said advertisement information storage means, advertisement information relating to the designated location, responsive to the detected current position agreeing with or being proximate to the designate location, and delivers the retrieved advertisement information to said mobile communication instrument (see figures 1, 2, 6 and 7, and col. 3, lines 51–62 and col. 13, line 45 to col. 14, line 40).

As per claim 4, Obradovich et al discloses that said advertisement information delivery apparatus includes delivery data storage means for storing number of deliveries of advertisement information to mobile communication instruments (see col. 15, lines 40–45).

As per claim 5, Obradovich et al discloses that said advertisement information delivery apparatus includes use data storage mans for storing number of times mobile communication instruments are to be delivery targets

of advertisement information , each time advertisement information is delivered thereto (see col. 15, lines 40–45).

As per claim 6, Obradovich et al discloses that the advertisement information stored in said advertisement information storage means includes images data picturing an advertisement including at least guide map wherein said mobile communication instrument includes a display screen for displaying the pictured advertisement based on said image data (see figures 1, 2, 6 and 7, and col. 3, lines 51–62 and col. 13, line 45 to col. 14, line 40).

As per claim 7, Obradovich et al discloses that said advertisement information storage means (230) stores location positions information for retrieving a path from a current position to an advertisement location and wherein said mobile communication instrument includes a display screen for displaying said path (see figures 1, 2, 6 and 7, and col. 3, lines 51–62 and col. 13, line 45 to col. 14, line 40).

As per claims 8 and 9, Obradovich et al discloses delivery condition storage means (230) for storing delivery conditions for the advertisement information, whereby said advertisement information delivery apparatus

determined delivery to said mobile communication instrument according to said delivery condition, wherein said delivery conditions can be one of presentation calendar period, presentation time of day (see col. 9, lines 23–54, and col. 26–30).

As per claims 10–12, Obradovich et al discloses that said mobile communication instrument is a navigation device carried by a vehicle and a mobile telephone (see (141) of figure 1), said navigation device comprising a transmitter (205) for transmitting current position information (detected by said navigation device) to said advertisement information to said advertisement information delivery apparatus, and a receiver (205) for receiving the advertisement information through said mobile phone (see figures 2 and 3, and col. 5, lines 15–30).

Claim Rejections – 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

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would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obradovich et al in view of Owensby (6,647,257).

As per claim 2, see figures 2-4, 6 and 7, and col. 5, line 16 to col. 15, line 20, Obradovich et al discloses a method (see figure 2) comprising:

step (230) of designating, by a sponsor of the advertisement information, a location at which the advertisement information is to be delivered to a mobile communication instrument (109);

step (230) of storing in memory the advertisement information to be presented at designated location;

step (109) of transmitting information for the current position of the mobile communication instrument from the mobile communication instrument to an advertisement information delivery apparatus remote from the mobile communication instrument and including the memory (see also (323) of figure 3);

step (230) of retrieving advertisement information relating to the current position from the memory based on the current position information received from the mobile communication instrument; and

step (230) of delivering the retrieved advertisement information to the mobile communication instrument.

Obradovich et al does not disclose step of calculating advertisement delivery charges for the delivery. In the same endeavor, Owensby discloses step (28, 30) of calculating advertisement delivery charges for a delivery (see figure 2, and col. 2, lines 65 to col. 3, line 2, and col. 15, lines 24–31).

Therefore, it would have been obvious for one skilled in the art to implement Obradovich et al invention with step/means calculating advertisement delivery charges for the delivery, as taught by Owensby, so that Obradovich et al invention in view of Owensby would be enhanced with the additional feature of calculating advertisement delivery charges for the delivery. Further, step of charging the calculated advertisement delivery charges to the sponsor is inherently included in Obradovich et al invention in view of Owensby since the

advertisement delivery charges would be subsidized by the sponsor (see Owensby, col. 2, lines 65 to col. 3, line 2).


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D Phu whose telephone number is (703) 305-8635. The examiner can normally be reached on 8:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-301-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-8635.

Sanh D. Phu
Examiner
Art Unit 2682


LEE NGUYEN
PRIMARY EXAMINER

SP